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Mailed :

In re Application of

Jean C. Congard et al.

Serial No. 09/982,141

Filed: October 19, 2001

For: DEVICE AND METHOD FOR SUPPLYING ATOMIZERS, AND SPRAYING
INSTALLATION EQUIPPED WITH SUCH A DEVICE

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:
: DECISION ON
: PETITION
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This is a decision on the PETITION UNDER 37 CFR 1.144 TO WITHDRAW THE
RESTRICTION REQUIREMENT mailed August 6, 2003 and made final in the office action
mailed October 16, 2003.

On August 6, 2003, a two way restriction requirement was made by the examiner. The examiner took the position that the groupings of claims were related as process and apparatus for its practice. Applicants traversed the restriction requirement in a response filed September 8, 2003. The examiner repeated the restriction requirement in an office action mailed October 16, 2003 and made the restriction requirement final. Applicants continued to argue the restriction requirement in a response filed January 15, 2004. Applicants added a linking claim in this response. The examiner prepared an action that was mailed on February 5, 2004 stating that the application was in condition for allowance except for the presence of non-elected claims with traverse. Applicants were given a one month time period to either cancel the non-elected claims or take other appropriate action. On May 6, 2004 a new non-final office action was mailed, withdrawing the indicated allowability of claims 7 and 11. Claims 1-6, 12 and 13 were withdrawn from consideration as being drawn to a non-elected invention.

On March 5, 2004, the instant petition under 37 CFR 1.144 was filed to formally request the withdrawal of the restriction requirement.

Applicant's position for the withdrawal of the restriction requirement is that the examiner has not shown that the separate groups are distinct.

DECISION

Sections 803 and 806.05(c) of the MPEP state:

803 Restriction - When Proper

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - §

806.05(e) Process and Apparatus for Its Practice — Distinctness

In applications claiming inventions in different statutory categories, only one-way distinctness is generally needed to support a restriction requirement. See MPEP § 806.05(c).

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another and materially different process.

If the apparatus claims include a claim to “means” for practicing the process, the claim is a linking claim and must be examined with the elected invention. If it is ultimately allowed, rejoinder is required. See MPEP § 809.04.

In making the restriction final, the examiner states that the inventions are distinct because the apparatus as claimed can be used to perform another process. The examiner explains that the apparatus could be used in a process in which the apparatus could be used to supply cleaning products.

Petitioner argues that the material differences argued by the examiner are contrary to the limitations of the device claims. It is argued that claim 1 requires a device for supplying coating products. Thus the device is for supplying precisely the same products as the claimed method.

This argument is not persuasive. It is well settled that method limitations and/or intended use limitations do not distinguish a claimed apparatus over a prior art apparatus. The limitation that the device is for supplying coating products does not impart any structure to the actual apparatus but is rather an intended use limitation. Because the intended use limitations do not have any bearing on the structure claimed, the examiner has in fact drawn a distinction with the apparatus as claimed. Therefore, the original restriction is proper.

The linking claim added by applicants will now be addressed.

Section 809 of the MPEP states in part:

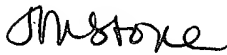
809 Claims Linking Distinct Inventions

Where, upon examination of an application containing claims to distinct inventions, linking claims are found, restriction can nevertheless be required. See MPEP § 809.03 for definition of linking claims.

The linking claims must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn. Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability. Where such withdrawn claims have been canceled by applicant pursuant to the restriction requirement, upon the allowance of the linking claim(s), the examiner must notify applicant that any canceled, nonelected claim(s) which depends from or includes all the limitations of the allowable linking claim may be reinstated by submitting the claim(s) in an amendment. Upon entry of the amendment, the amended claim(s) will be fully examined for patentability.

In the instant application, the examiner did not correctly follow the guidelines set forth above. Linking claim 13 should have been examined along with the elected claims and treated in the non-final office action mailed May 6, 2004. Accordingly, the petition to withdraw the restriction requirement is **GRANTED-IN-PART**. The application is being forwarded to the examiner to examine linking claim 13 along with the other elected claims.

If the linking claim is found to be allowable, then the restriction must be withdrawn. If the examiner finds that the linking claim is not allowable, then the restriction requirement can be maintained. A new non-final office action should be prepared including treatment of linking claim 13, and if necessary, withdrawal of the restriction requirement.



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